

Application No. 10/024,269  
Amendment dated December 22, 2004  
Office Action dated September 22, 2004

### **Remarks**

Applicants have canceled claims 53-57 and added new claims 58-60 the support for which is found at page 7, lines 10-15. Claims 45-52 and 58-60 remain in the application, and re-examination and reconsideration of the application are respectfully requested.

Claims 45-52 are rejected under 35 U.S.C. §103(a) as being unpatentable over Watanabe (Japanese Publication No. 52-118,390) in view of Davis (U.S. Patent No. 3,960,268). Referring to Fig. 4 of Watanabe, a wafer support member 3 has a connection portion 6 that connects to lower ends of opposed projections 9. Fixing parts 8 are connected to the top ends of the projections 9 and fit into respective grooves 17 on opposite sides of a box 2. The connecting portion 6 of the support member 3 is fixed to a bottom surface of the box 2 by means of rivets 14. Thus, the wafer support member 3 is permanently attached to the box 2. A lid 1 has a wafer-top holder 4 attached to its back side. Thus, when wafers 5 are placed in openings between the projections 9 and the lid 1 is placed on the box 2, the wafer-top holder 4 pushes against the tops of the wafers 5; and the projections 9 bend slightly downward as shown in Fig. 4, thereby securing the wafers 5 in the box 2.

Referring to Fig. 1 of Davis, a frame 1 has racks 10 and 11 that are spaced apart on a pair of rods 13, 14 to accommodate specimen slides of different widths. End pieces 18, 19 have a triangular cross section to maintain an orientation between base sides 16 and angular sides 17 of respective racks 10, 11. After slides 5 are inserted into the racks 10, 11, the racks are slid together on the rods 13, 14 to cause a slight deformation of inside surfaces of apertures 20 bearing against the slides. This slight deformation creates a retaining force to maintain the slides in firm engagement with the racks 10, 11, col.2, lines 59-68.

In order to establish a prima facie case of obviousness, it is necessary that the Office Action present evidence, preferably in the form of some teaching, suggestions, incentives or inference in the applied prior art or, in the

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form of generally available knowledge, that one having ordinary skill in the art would have been led to arrive at the claimed invention. Applicants submit that a prima facie case of obviousness is not made because Watanabe and Davis do not teach, suggest or motivate one to provide the following elements recited in Claim 45:

1. A rack 24 having a frame 30 with substantially planar and opposed end walls 34. In Watanabe, the rack 3 is a generally U-shaped structure that has no end walls. In Davis, the racks 10, 11 are adjustably supported on a pair of cylindrical rods 13, 14 that are not planar end walls.

2. A rack comprising a frame having planar end walls with ends rigidly connected to ends of planar side walls. In Watanabe, the sides of the rack 3 are not connected to anything at their ends. In Davis, the racks 10, 11 are adjustably supported on a pair of cylindrical rods 13, 14; and thus, the ends of the racks 10, 11 are not rigidly connected to any structure.

3. The rack is removably positionable within a base having a cover. In contrast, in Watanabe, the rack 3 is permanently fixed to a box 2 by rivets 14. Further, the racks 10, 11 in Davis are not removably positionable in a base having a cover but instead, as shown in Fig. 6, are enclosed within a heat shrinkable envelope 40. Such an envelope 40 can be used only once. In contrast, the claimed rack can be removably positioned in the base any number of times as required by a particular process. Such applications are described at page 6, lines 15-24, page 7, lines 17-21, lines 27-30, and line 33.

Applicants further submit that a prima facie case of obviousness is not made because there is nothing in the cited references to suggest their combination. As described at column 1, lines 43-50, the purpose of the Davis structure is to provide a loose and adjustable rack to accommodate slides of different sizes. As further described at column 2, lines 59-68, slides of different widths are accommodated by sliding the racks 10, 11 toward each other to create a retaining force to maintain the slides in firm engagement with

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the racks. The loose frame 1 of Davis is packaged in an envelope of a heat-shrink material. The Office Action cites Davis as showing a loose rack as recited in claim 45. However, there is nothing in Davis that describes, suggests or motivates one to substitute the wafer support member 3 in Watanabe with the loose frame 1 of Davis. Nothing in either reference suggests that such a combination is desirable or would have any advantages.

In view of the above, Applicants submit that claims 45-52 are patentable and not obvious under 35 U.S.C. §103(a) over Watanabe (Japanese Publication No. 52-118,390) in view of Davis (U.S. Patent No. 3,960,268).

Applicants respectfully submit that the application is now in condition for allowance and reconsideration of the application is respectfully requested. The Examiner is invited to contact the undersigned in order to resolve any outstanding issues and expedite the allowance of this application.

Respectfully submitted,

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